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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,523	12/02/2003	Paulo Marques	SP02-251	8280
22928	7590	03/30/2006	EXAMINER	
CORNING INCORPORATED			BOLDEN, ELIZABETH A	
SP-TI-3-1			ART UNIT	
CORNING, NY 14831			PAPER NUMBER	
			1755	
DATE MAILED: 03/30/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/728,523

Applicant(s)

MARQUES, PAULO

Examiner

Elizabeth A. Bolden

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 7-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/2/03</u> . | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of Group I, claims 1- 6 in the reply filed on 9 March 2006 is acknowledged.

The requirement is still deemed proper and is therefore made FINAL.

### ***Priority***

Acknowledgment is made of applicant's claim for foreign priority based on an application filed at the European Patent Office on 3 December 2002. It is noted, however, that applicant has not filed a certified copy of the European application as required by 35 U.S.C. 119(b).

### ***Oath/Declaration***

The Bibliographic Data Sheet refers to a foreign application filed 3 December 2002 at the European Patent Office with application number 02 292 981.4. However, neither the oath nor the transmittal letter claims priority to this application. Applicant has not complied with the requirements of 37 CFR 1.63(c), since the oath, declaration or application data sheet does not acknowledge the filing of any foreign application. A new oath, declaration or application data sheet is required in the body of which the present application should be identified by application number and filing date.

### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on 2 December 2003 has been considered by the Examiner.

### ***Specification***

The Examiner request that the Applicant update the Cross-Reference To Related Application section in the specification.

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### ***Drawings***

The drawings filed 2 December 2003 have been accepted by the Examiner.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949).

In the present instance, claim 6 recites the broad recitation where SiO<sub>2</sub> is from 68 to 73 wt%, Al<sub>2</sub>O<sub>3</sub> is from 8 to 15 wt%, and ZrO<sub>2</sub> is from 1-3 wt%, and the claim also recites that "the sum of the weight percents of SiO<sub>2</sub>, Al<sub>2</sub>O<sub>3</sub>, and ZrO<sub>2</sub> is less than 78% by total composition weight", which is the narrower statement of the range/limitation. This is indefinite since it is only possible to use the lowest value in each component plus 1 additional weight percent of one of the three components. It does not enable one of ordinary skill in the art to use a glass having a maximum in one of the three components and still meet the latter limitation.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Kosokabe et al., U.S. Patent 5,747,399.

Kosokabe et al. disclose a glass composition in Examples 18, 26, 29, and 31, which anticipates all the compositional and CTE limitations of instant claims 1-3. See Tables 4, 6, and 7. Kosokabe et al. disclose the glass's compositional ranges and range of CTE. See Abstract and column 2, lines 22-29 and 33-38. These compositional and CTE ranges of Kosokabe et al. are sufficiently specific to anticipate the glass recited in claims 1-3 and 6. See MPEP 2131.03.

Since the composition of the reference is the same as those claimed herein it follows that the glasses of Kosokabe et al. would inherently possess the devitrification resistance, softening point, weight losses in acid and alkali resistance tests properties as recited in claims 1 and 6. See MPEP 2112.

Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Kunert et al., U.S. Patent 6,204,212.

Kunert et al. disclose a glass composition in Example 1, which anticipates all the compositional and CTE limitations of instant claims 1-3. See Table 1. Kunert et al. disclose the glass's compositional ranges and range of CTE. See Abstract, column 2, lines 21-42, column 3, line 62 to column 4, line 6, and column 4, lines 63-64. These compositional and CTE ranges of Kunert et al. are sufficiently specific to anticipate the glass recited in claims 1-5. See MPEP 2131.03.

Since the composition of the reference is the same as those claimed herein it follows that the glasses of Kunert et al. would inherently possess the devitrification resistance property as recited in claim 1. See MPEP 2112.

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Claims 1-5 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Clifford, U.S. Patent 5,304,516.

Clifford discloses a glass composition in Examples 34-36, 39, 42, and 43, which anticipates all the compositional and CTE limitations of instant claims 1-5. See Table 3. Clifford discloses a glass composition in Examples 30, 31, 41, 44, and 87, which anticipates all the compositional and CTE limitations of instant claims 1, 2, 4, and 5. See Table 3.

Since the composition of the reference is the same as those claimed herein it follows that the glasses of Clifford would inherently possess the devitrification resistance property as recited in claim 1. See MPEP 2112.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al., U.S. Patent 5,747,395.

Smith et al. teaches a glass composition having overlapping ranges of components with instant claims 1-6. See Abstract and column 2, lines 35-53. Smith et al. teaches that the glass has an overlapping range of the coefficient of thermal expansion with instant claims 1 and 6. See column 4, line 67 to column 5, line 3.

Smith et al. fail to teach any examples or compositional or property ranges that are sufficiently specific to anticipate the compositional limitations of claims 1-6. However, overlapping ranges have been held to establish prima facie obviousness. See MPEP 2144.05.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have selected from the overlapping portion of the ranges disclosed by the reference because overlapping ranges have been held to establish prima facie obviousness. See MPEP 2144.05.

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One of ordinary skill in the art would expect that a glass with overlapping compositional ranges would have the devitrification resistance, softening point, weight losses in acid and alkali resistance tests properties recited in claims 1 and 6.

### ***Conclusion***

The additional references cited on the 892 have been cited as art of interest since they are considered to be cumulative to or less than the art relied upon in the rejections above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth A. Bolden whose telephone number is 571-272-1363. The examiner can normally be reached on 9:30 am-6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EAB

19 March 2006

  
J.A. LORENGO  
SUPERVISORY PATENT EXAMINER